

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended, and in light of the following discussion, is respectfully requested.

Claims 1, 5-6, 8-12, 14-23 and 25-37 are pending in the present application. Claims 1, 5, 11-12, 14, 22-23, 25-26 and 36-37 are amended, and Claims 2-4 and 7 are cancelled. Support for the changes to the claims is found in the originally filed claims. No new matter has been added.

This amendment is submitted in accordance with 37 C.F.R. §1.116, which after final rejection permits entering of amendments canceling claims, complying with any requirement of form expressly set forth in a previous Office Action, or presenting rejected claims in better form for consideration on appeal. The present amendment places the claims in condition for allowance, and does not raise new issues requiring further consideration and/or search. Therefore, it is respectfully requested that the present amendment be entered under 37 C.F.R. §1.116.

In the Official Action, Claims 1, 14-21 and 25-35 were rejected under 35 U.S.C. §101; and Claims 1-12, 14-23 and 25-37 were rejected under 35 U.S.C. §102(b) as anticipated by EP 1 107 595 (Yoshida).

Initially, the Office Action does not address Applicant's arguments submitted in the response filed on June 22, 2009, regarding the outstanding rejection of Claims 1, 14-21 and 25-35 under 35 U.S.C. §101. The Examiner is kindly reminded, "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."¹ On the other hand, the Office Action merely repeats the rejections. Therefore, it is unclear whether the rejection was maintained in error.

¹ MPEP §707.07(f).

Should the rejection be maintained, it is respectfully submitted Claims 1, 14-21 and 25-35 recite means-plus-function elements under 35 U.S.C. §112, sixth paragraph, and the claims have not been examined properly in light of this statute. Specifically, 35 U.S.C. §112, sixth paragraph, states:

“[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and ***such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.***”²

Therefore, proper claim interpretation of a means-plus-function element entails consideration of the ***structures disclosed in the specification*** and equivalents thereof. Consequently, it is improper for the Examiner to interpret the claimed means-plus-function elements as an abstract idea or descriptive material *per se*.

For the Examiner’s convenience, portions of the MPEP are reproduced below which offer guidance for examination in light of 35 U.S.C. §112, sixth paragraph. In determining the scope of the claims prior to determining compliance with each statutory requirement for patentability, MPEP § 2106 provides:

Where means plus function language is used to define the characteristics of a machine or manufacture invention, ***such language must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof" that correspond to the recited function.*** Two en banc decisions of the Federal Circuit have made clear that the USPTO is to interpret means plus function language according to 35 U.S.C. § 112, sixth paragraph. *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (*en banc*); *In re Alappat*, 33 F.3d 1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (*en banc*).

Disclosure may be express, implicit, or inherent. Thus, at the outset, USPTO personnel must attempt to correlate claimed means to elements set forth in the written description that perform the recited step or function. The written description includes the original specification and the drawings and USPTO personnel are to give the claimed means plus function limitations their broadest reasonable interpretation consistent with all corresponding structures or materials described in the specification and their equivalents including the manner in which the claimed functions are performed. See

² 35 U.S.C. §112, sixth paragraph (emphasis added).

Kemco Sales, Inc. v. Control Papers Company, Inc., 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). Further guidance in interpreting the scope of equivalents is provided in MPEP § 2181 through § 2186.

Therefore, should the rejection of Claims 1, 14-21 and 25-35 be maintained in a subsequent communication, Applicant respectfully requests that the Examiner indicate how the written disclosure, including the drawing figures, does not provide support for the means-plus-function elements of the claims. Specifically, a rejection (if appropriate) from the Examiner should indicate how the structure or materials disclosed in the specification is insufficient for performing the claimed functions, and the rejection should be made under 35 U.S.C. §112, second paragraph - *not 35 U.S.C. §101*.

Further, enclosed herewith is a memorandum dated September 2, 2008, from Deputy Commissioner for Patent Examination Policy John Love regarding the above-noted issue. This memorandum provides instructions for examination of claim limitations invoking 35 U.S.C. §112, sixth paragraph, and what rejections are appropriate should the claims or specification be deficient.

The Examiner is encouraged to contact the undersigned to further discuss this rejection. Otherwise, it is respectfully submitted the rejection of Claims 1, 14-21 and 25-35 under 35 U.S.C. §101 is improper and should be withdrawn.

As to the rejection under 35 U.S.C. §102(b) in view of Yoshida, Yoshida is a European patent application which claims priority to JP publication No. 2001-160955, which is discussed in paragraphs [0007] to [0014] of this application as published. As discussed therein, Yoshida describes a vector is added in advance to a broadcast program as attributes of the program. Then, a selection vector is compared with the attribute vector to select a program to be recorded or reproduce. The selection vector is a vector generated from initial data recorded by a user and *average values* of attributes represented by attribute vectors of programs reproduced by the user or programs scheduled to be recorded.

One disadvantage of such a system is that there is a low degree of precision to select a program matching *a favorite* of the user.³ The claimed invention of this application, however, addresses this disadvantage amongst others, by associating weight information based on a genre of a content. In particular, amended Claim 1 recites:

Claim 1 recites:

An information-processing apparatus for generating attribute information of a content on the basis of information on said content, comprising:

acquisition means for acquiring said information on said content;

attribute-information generation means for generating said attribute information including a plurality of items on the basis of said information acquired by said acquisition means as said information on said content;

first storage means for storing first weight information for said items of said attribute information generated by said attribute-information generation means, said first weight information prescribing a degree of contribution given by each of said items for computing a degree of similarity between said attribute information and predetermined favorite information of a user; and

transmission means for transmitting said attribute information generated by said attribute-information generation means, *extracting a piece of first weight information matching a genre of said content from pieces of first weight information stored in said first storage means*, and transmitting said extracted piece of first weight information by *associating said extracted piece of first weight information with said attribute information* generated by said attribute-information generation means.

[Emphasis added].

As amended, Claim 1 currently recites the features previously recited in Claims 2-4.

In particular, attribute information is generated, which includes a plurality of items on the basis of information acquired on a content. The first storage means stores first weight information for items of the attribute information of the content. The first weight information prescribes a degree of contribution given by each of the items for computing a degree of similarity between the attribute information and predetermined favorite information of a user. A transmission means extracts a piece of the first weight information matching a genre of the content, and associates the extracted first weight information with the generated attribute

³ Specifically, see paragraphs [0008], [0010] and [0012] of this application as published.

information. The Office Action states that Yoshida discloses these features. Applicant respectfully disagrees.

As noted above, Yoshida describes an attribute vector A for a content and a selection vector S, which indicates a user's taste. However, Yoshida is silent regarding extracting first weight information matching a genre of the content, and associating the extracted first weight information attribute information of the content. As a result, Yoshida does not anticipate Claim 1 (or any claim depending therefrom).

Although directed at different statutory classes and/or varying in scope, Claims 11-12, 14, 22-23 and 25 are not anticipated by Yoshida for substantially similar reasons to those noted above regarding Claim 1. Therefore, it is respectfully submitted the rejection of Claims 1, 11-12, 14, 22-23 and 25 (and any claims depending therefrom) under 35 U.S.C. §102(b) in view of Yoshida should be withdrawn.

As to the remaining claims, Claim 26 recites:

An information-processing apparatus for carrying out processing to select a content matching a favorite of a user, comprising:
acquisition means for acquiring attribute information of said content;
and
bias-information generation means for generating, *on the basis of first information showing said favorite of said user and second information showing a generally preferred favorite for a genre of said content*, third information revealing a bias of said favorite of said user as a bias with respect to said generally preferred favorite.
[Emphasis added].

As noted above, Claim 26 recites acquiring attribute information for a content, and generating bias information (third information), based on information showing a favorite of a user (first information) and information showing a generally preferred favorite for a genre of the content (second information). The Office Action alleges Yoshida anticipates these features. Applicant respectfully disagrees.

The Office Action alleges the information showing a favorite of a user is vector A of Yoshida. However, Yoshida states vector A is an attribute vector of broadcast content.⁴ Further, the Office Action alleges the information showing a generally preferred favorite for a genre of the content is vector S of Yoshida. However, Yoshida states vector S is a selection vector indicating a user's taste.⁵

Further, Yoshida does not take into account information regarding a generally preferred favorite for a genre, as recited in Claim 26. Yoshida merely describes an attribute vector for a broadcast content and a selection vector indicating a user's taste. Therefore, it is respectfully submitted Yoshida fails to anticipate generating bias information on the basis of information showing a favorite of a user (first information) and information showing a generally preferred favorite for a genre of the content (second information), as recited in Claim 26.

Although directed at different statutory classes and/or varying in scope, Claims 36-37 are not anticipated by Yoshida for substantially similar reasons to those noted above regarding Claim 26. Therefore, it is respectfully submitted the rejection of Claims 26 and 36-37 (and any claims depending therefrom) under 35 U.S.C. §102(b) in view of Yoshida should be withdrawn.

⁴ Yoshida, Abstract.

⁵ Yoshida, Abstract.

Consequently, in view of the foregoing amendment and remarks, it is respectfully submitted this application is in condition for allowance, and such action is respectfully requested at an early date.

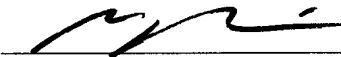
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